

### **REMARKS**

Applicant respectfully requests the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

#### **Status of the Claims**

Claims 1 and 3-8 are pending in the present application. Claims 1 and 8 have been amended. Support for the recitations of claims 1 and 8 can be found in the present specification, *inter alia*, at page 1, lines 21-22. No new matter has been added by way of the above amendments.

Applicant submits that the present Amendment is merely formal in nature, reduces the number of issues under consideration, and places the case in condition for allowance. Entry of the present amendment is proper to place the claims in better form for appeal.

In view of the following remarks, Applicant respectfully requests that the Examiner withdraw all rejections and allow the currently pending claims.

#### **Issues under 35 U.S.C. § 102(b)**

The Examiner has rejected claims 1 and 8 under 35 U.S.C. § 102(b) as being anticipated by Yoichiro et al. '400 (JP 11-176400). Applicant respectfully asserts that Yoichiro et al. '400 do not disclose each and every element of independent claims 1 and 8. Therefore, Yoichiro et al. '400 do not anticipate or render obvious claims 1 and 8.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

*Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) combining prior art elements according to known methods to yield predictable results;
- (b) simple substitution of one known element for another to obtain predictable results;
- (c) use of known technique to improve similar devices (methods, or products) in the same way;
- (d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (e) “obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success
- (f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

*Distinctions over the Cited Art*

As amended, independent claim 8 recites, *inter alia*, that the first case body comprises “a dish-shaped case element A with a housing portion swelling from one surface and a reinforcing frame fixed to the dish-shaped case element A along a circumference of a swelling wall of the housing portion” and a second case body comprising “a plate-shaped case element B.” Claim 1 contains a limitation that is substantially similar. The present invention allows the structural strength of the battery to be increased while the total thickness of the battery can be reduced.

The claims have been amended to further highlight the differences between the present invention and Yoichiro et al. ‘400. In responding to Applicant’s previous arguments, the Examiner alleges that the limitation of “either” in claims 1 and 8 does not require that the second case body does not also have the claimed feature. As amended, the claims now explicitly recite that the first case body comprises a dish-shaped case element A and the second case body comprises a plate-shaped case element B.

In stark contrast, Yoichiro et al. ‘400 do not describe an outer case including a first case body having a dish-shaped case element A and a second case body having a plate-shaped case element B.

Furthermore, in the battery described in Yoichiro et al. ‘400, thick resin frames (2c, 3c) are provided on both an upper case (2) and a lower case (3) so that the total thickness of the battery increases, which makes it impossible to reduce the thickness of the battery. Moreover, Figure 3 of Yoichiro et al. ‘400 shows an example in which reinforcing portions (2b, 3b) of the upper and lower cases (2, 3) swell outward. According to this structure as well, the total

thickness of the battery increases, which makes it impossible to reduce the thickness of the battery.

Additionally, in Yoichiro et al. '400, the upper case (2) and the lower case (3) are connected via the resin frames (2c, 3c), and according to this connection method, the increase in thickness of the battery cannot be avoided.

In contrast, according to the present invention, the connection walls made of a metal thin plate are connected to each other so that the increase in total thickness of the battery can be avoided.

As described above, claims 1 and 8 are not anticipated by Yoichiro et al. '400 since the reference does not teach or provide for each of the limitations recited in the pending claims. Withdrawal of the rejection is respectfully requested.

For completeness, Applicant also respectfully submits that Yoichiro et al. '400 do not render the present invention obvious because the reference provides no disclosure, reason, or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed.

**Issues under 35 U.S.C. § 103(a)**

1) The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Yoichiro et al. '400 and further in view of Hasegawa et al. '630 (US 6,319,630).

2) The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Yoichiro et al. '400 modified by Hasegawa et al. '630 and further in view of Kozu et al. '766 (EP 1033766).

3) The Examiner has rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Yoichiro et al. '400 modified by Hasegawa et al. '630 and further in view of Kaneda et al. '063 (WO 00/59063).

4) The Examiner has rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Yoichiro et al. '400 and further in view of Higuchi '004 (US 6,154,004).

Applicant respectfully traverses, and reconsideration and withdrawal of these rejections are respectfully requested.

As discussed above, Yoichiro et al. '400 do not disclose each and every aspect of claim 1, from which claims 3-7 ultimately depend. Applicant respectfully submits that the other cited references do not overcome the deficiencies of this reference.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be disclosed by the prior art. As discussed above, the combination of references fails to disclose all the claim limitations of independent claim 1, and those claims dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejections is respectfully requested.

For the reasons given above, the combination of references does not render the present invention obvious because the cited references do not disclose at least one feature of the present invention and its effects. Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Any contentions of the USPTO to the contrary must be reconsidered at present. Reconsideration and withdrawal of these rejections are respectfully requested.

**CONCLUSION**

A full and complete response has been made to all issues as cited in the Office Action. Applicant has taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicant respectfully requests that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1 and 3-8 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: OCT 09 2008

Respectfully submitted,

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